

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

REMARKS

In view of the following discussion, the Applicants submit that none of the claims now pending in the application is obvious under the provisions of 35 USC § 103. Thus, the Applicants believe that all of these claims are now in allowable form.

If the Examiner believes that there are any unresolved issues in any of the claims now pending in the application, the Examiner is urged to telephone Alberta A. Vitale, Esq. at (203 469-0696) so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Claim Amendments

No claim amendments have been made in the present response.

Rejections under 35 USC § 103

The Office Action has rejected claims 1-21 under the provisions of 35 USC § 103 as being obvious over the teachings in the Angles et al patent (United States patent 5,933,811 issued to Paul D. Angles et al on August 3, 1999 (hereinafter Angles '811)) taken in view of the Balassanian patent (United States patent 6,324,685 issued to Edward Balassanian on Nov. 27, 2001 (hereinafter

Appl. No. 09/616,605  
Amdt. dated May 11, 2004  
Reply to Office Action of Feb. 12, 2004

Balassanian '685)). This rejection is respectfully traversed.

For simplification, the Applicants will specifically discuss this rejection in the context of independent claims 1, 10 and 19 which were addressed in the Detailed Action as a group.

Claims 1, 10 and 19

The Office Action, at page 2, paragraph 3, states that:

As per claims 1, 10 and 19, Angles disclosed a method and a system of delivering customized advertisements within interactive communication systems wherein a client/consumer downloaded a web page file from a web server, the web page file including at least one advertisement fragment. See Abstract, Fig. 3, steps referred to as 302, 304, col. 2, lines 62-66 and col. 3, lines 40-49. (emphasis added).

The claim language referenced by the Office Action appears to be a paraphrased interpretation of the language of several claims. Applicants do not endorse this paraphrased language and will address the rejection and citations as they pertain to the exact language of the claims.

The language of the independent claims for which Applicants assume, for the sake of argument, the Office Action is referring to is as follows:

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

(Claim 1, step a (method)): "downloading a Web page file from a Web server, the Web page file including at least one advertising fragment;" (emphasis added)

(Claim 1, step c (method)): "running the advertising applet program within the context of the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement." (emphasis added)

(Claim 10, clause 1 (apparatus)): "a Web browser requesting a Web page stored on a Web server containing an advertising fragment;" (emphasis added)

(Claim 10, clause 3 (apparatus)): "the advertising applet program constructing the advertisement banner on the client computer for display in the Web browser." (emphasis added)

(Claim 19, clause 2, (computer program product)): "download a Web page file from a Web server, the Web page file including at least one advertising fragment". (emphasis added)

(Claim 19, last clause, (computer program product)): run the advertising applet program within the context of the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement.". (emphasis added)

Referring now to the citations of the Office Action, recited below for efficiency:

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

Col. 2, lines 62-66:

Preferably, when a consumer accesses a content provider, the content provider transmits an electronic document to the consumer. Embedded within the electronic document is a advertisement request. When the consumer's computer displays the electronic document, the embedded advertisement request directs the consumer computer to communicate with an advertisement provider. In response, the advertisement provider provides a customized advertisement. The advertisement provider then tracks the consumer's response to the customized advertisement. (emphasis added)

Col. 3, lines 40-49:

After obtaining the advertisement request, the content provider embeds the advertisement request into its electronic documents. When a registered consumer accesses a content provider's website, the content provider website transfers the electronic document and the embedded advertisement request to the consumer's computer. The embedded advertisement request directs the consumer computer to invoke the referenced content provider script in the advertisement provider computer. The advertisement provider executes the content provider script and obtains the content provider member code. The advertisement provider uses the content provider member code to track the number of advertisements displayed by a particular content provider. (emphasis added)

Applicants note that in Angles '811 "the advertisement provider provides a customized advertisement" and also "[t]he embedded advertisement request directs the consumer computer to invoke the

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

referenced content provider script in the advertisement provider computer. The advertisement provider executes the content provider script. This is much different than Applicants' claimed invention "running the advertising applet program within the context of the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement" (claim 1, step c (method)); the advertising applet program constructing the advertisement banner on the client computer for display in the Web browser" (claim 10, clause 3 (apparatus)); or "run the advertising applet program within the context of the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement" (claim 19, last clause, (computer program product)). In fact, Angles '811 is counterintuitive to the advantages of Applicants invention. Applicants' advantages are stated in the specification as follows:

[I]n the context of the World Wide Web, creating and storing customized advertisements for specific users is cumbersome because a large number of individual advertisements may be required to appeal to individuals in a specific audience. Managing a large number of advertisements is costly, both in terms of storage and processing. Delivering customized advertisements to a large user population, for products and services that have many options, could quickly overwhelm even a large, powerful Web server.

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

The present invention overcomes these problems by dynamically creating the advertisement on the user's computer using information obtained about the user at the time of displaying the advertisement. When a user requests a Web page containing an advertisement banner, a fragment of the banner is returned in the Web page along with a reference to an applet. The applet contains logic for deciding how to choose from among various possible elements which are needed to complete the construction of the advertisement banner. The logic may, for example, obtain information about the specific user and requests additional advertisement content from Web servers to complete the creation of the advertisement to be displayed to the user.

More specifically, both a method and apparatus may be provided for creating customized advertisement banners for Web pages. The advertisement banners are customized for specific users based upon information about the specific user viewing the page or based upon other criteria by using an applet program which is within the context of the browser program running on the user's computer. The user is identified by either an identifier stored on the user's computer or from the user's interaction with the Web page containing the advertisement banner. Once user specific information is obtained, specific advertisement content is obtained from one or more Web server computers and the advertisement banner is dynamically constructed and displayed on the user's computer using that specific content.

An advantage of this dynamic construction within the context of the browser is that the advertisement content can easily and inexpensively be tailored for the individual users; for example, if information about the user's occupation can be obtained, an area

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

of the advertisement that scrolls news stories might target stories related to that user's occupation. This may be done to draw a user's attention to the advertisement banner.

An additional advantage of dynamically constructing the advertisement on the user's computer is that it requires less storage at the Web server and less bandwidth over the network. This is a result of being able to eliminate the need to create, store and send all possible combinations of advertisement for a target audience. (specification, pages 2-4, emphasis added).

Further, the Office Action, at page 2, paragraph 3, states that:

Angles disclosed *locating an advertisement program in the advertising provider/server based on the advertisement fragment embedded within the document where the advertisement server contained an advertising module/program stipulating steps in constructing customized advertisements.* See Fig. 3, steps referred to as 306, 308, and 310, Fig. 4, col. 2, lines 54-59, col. 2, line 66 through col. 3, line 5. (emphasis added).

Again, Applicants note that the claim language referenced by the Office Action appears to be a paraphrased interpretation of the language of several claims. Applicants do not endorse this paraphrased language and instead will address the rejection and citations as they pertain to the exact language of the claims.

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

The independent claim language, which Applicants assume, for the sake of argument, the Office Action refers to is as follows:

(Claim 1, clause 1 (method)): "a Web browser requesting a Web page stored on a Web server containing an advertising fragment;" (emphasis added)

(Claim 1, clause 2 (method)): "a reference to an advertising applet program on an applet server obtained using the advertising fragment;" (emphasis added)

(Claim 1, clause 3 (method)): "the advertising applet program constructing the advertisement banner on the client computer for display in the Web browser." (emphasis added)

(Claim 10, clause 1 (apparatus)): "a Web browser requesting a Web page stored on a Web server containing an advertising fragment;" (emphasis added)

(Claim 10, clause 2 (apparatus)): "a reference to an advertising applet program on an applet server obtained using the advertising fragment;" (emphasis added) and

(Claim 10, clause 3 (apparatus)): "the advertising applet program constructing the advertisement banner on the client computer for display in the Web browser." (emphasis added)

(Claim 19, clause 2, (computer program product)): "download a Web page file from a Web server, the Web page file including at least one advertising fragment;" (emphasis added)



Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

(Claim 19, clause 3, (computer program product)): "locate an advertising applet program on an applet server using the advertising fragment, the advertising applet program containing program logic specifying how to construct the customizable advertisement;" (emphasis added)

(Claim 19, clause 4, (computer program product)): "run the advertising applet program within the context of the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement." (emphasis added)

Applicants refer now to the citations of the Office Action, recited below, for efficiency):

Col. 2, lines 54-59:

In broad terms, the present invention includes a communications system having at least three different entities which communicate with each other. The entities include: a content provider, an advertisement provider and a consumer. (emphasis added)

Col. 2, line 66 through col. 3, line 5:

When the consumer's computer displays the electronic document, the embedded advertisement request directs the consumer computer to communicate with an advertisement provider. In response, the advertisement provider provides a customized advertisement. The advertisement provider then tracks the consumer's response to the customized advertisement. (emphasis added)

Applicants note that the mere use of the phrase "customizable advertisement in Angles '811 and Applicants' claimed invention is not enough to provide a teaching or

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

suggestion or Applicants' claimed invention. Similarity in the choice of nomenclature in the Angles specification as compared with Applicants' claim language is not enough to provide teaching of Applicants' claim element. As discussed above, nowhere in the citation is there any teaching or suggestion of Applicants' claimed "customizable advertisement" especially with respect to the location of construction of the advertisement.

The Office Action, at page 2-3, paragraph 3, further states that:

Angles showed a consumer receiving executable program enabling the browser at the client computer to display the customizable advertisement sent from the advertisement server. See col. 3, lines 23-28 and Figs. 3 and 4. (emphasis added).

Again, Applicants note that the claim language referenced by the Office Action appears to be a paraphrased interpretation of the language of several claims. Applicants do not endorse this paraphrased language and instead will address the rejection and citations as they pertain to the exact language of the claims.

The independent claim language for which Applicants assume, for the sake of argument, the Office Action is referencing is as follows:

(Claim 1, clause c (method)): "running the advertising applet program within the context of

Appl. No. 09/616,605

Amdt. dated May 11, 2004

Reply to Office Action of Feb. 12, 2004

the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement." (emphasis added)

(Claim 10, last clause (apparatus)): "the advertising applet program constructing the advertisement banner on the client computer for display in the Web browser." (emphasis added)

(Claim 19, last clause (computer program product)): "run the advertising applet program within the context of the browser program at the client computer to execute the program logic to construct the visual representation of the customizable advertisement." (emphasis added)

Once again Applicants refer to relevant citations of the Office Action, specifically, col. 3, lines 23-28, recited below for efficiency:

Col. 3, lines 23-28

The advertisement provider then retains a demographic profile of the consumer. In return, the advertisement provider assigns the consumer a unique member code. In an alternate embodiment, the consumer is sent unique software which enhances the consumer's Internet browser so that custom advertisements can be merged with electronic documents obtained from the content provider. (emphasis added)

Applicants respectfully disagree that this citation provides teaching of Applicants' claimed "constructing the advertisement banner on the client computer for display in the Web browser" (Claim 10, for example). As can be understood clearly from the above noted language, Angles '811 "custom advertisements"

Appl. No. 09/616,605  
Amdt. dated May 11, 2004  
Reply to Office Action of Feb. 12, 2004

obtained from "the advertisement provider" are "merged with electronic documents obtained from the content provider." Applicants' invention constructs the advertisement "on the client computer". This is not the same as obtaining the advertisement from "advertisement provider." This is also counterintuitive to Applicants advantages explained above and in the citation, including the "advantage of dynamically constructing the advertisement on the user's computer is that it requires less storage at the Web server and less bandwidth over the network (Specification, page 4)."

Thus, for all of the above stated reasons, Applicants respectfully note that the 35 USC § 103 rejection of independent claims 1, 10 and 19 is traversed.

Claims 2-9, 11-18 and 20-21

Dependent claims 2-9 depend directly or indirectly from independent claim 1. Dependent claims 11-18 depend directly or indirectly from independent claim 10. Dependent claims 20-21 depend directly or indirectly from independent claim 19. For the reasons given above with respect to independent claims 1, 10 and 19, Applicants respectfully traverse the 35 USC § 103 rejection of claims 2-9, 11-18 and 21.

Appl. No. 09/616,605  
Amdt. dated May 11, 2004  
Reply to Office Action of Feb. 12, 2004

Balassanian '685 Reference

With respect to the secondary reference  
Balassanian '685, the Office Action states:

An artisan who was aware of Angles's invention at the time the applicant's invention was made would have been motivated to look for teachings that may have allowed the use of applet programs and applet server. In these arts Balassanian disclosed an applet server and applet programs that provides applets in various forms based on requests received from client computers where the requests specified client-desired format in which the applets were to be delivered. See Abstract, Fig. 1 and col. 3, lines 9-64.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Balassanian related to applets and have modified the teachings of Angles related to customized advertising by using an applet server as a replacement or as an additional object for the advertisement server, because applets are platform independent ("the Java programming language is a robust, secure, architecture-neutral, portable, general-purpose programming language developed by Sun Microsystems. Java supports programming for the Internet in the form of independent Java applets"). See Angles col. 23, lines 20-24. (emphasis added).

Applicants will address this portion of the rejection as it pertains to the independent claims generally and specifically, for example, to the language of independent claim 1 which includes: "locating an advertising applet program on an applet server using the advertising fragment, the advertising applet program containing program logic

Appl. No. 09/616,605  
Amdt. dated May 11, 2004  
Reply to Office Action of Feb. 12, 2004

specifying how to construct the customizable advertisement." (emphasis added). Applicants have studied the claims, including independent claims 1, 10 and 19 and respectfully note that Applicants claim language does not include the "using an applet server as a replacement or as an additional object for the advertisement server" as stated in the Office Action.

Thus, Applicants note that Angles '811 in view of Balasanian '685 do not make Applicants claims obvious. Therefore, Applicants respectfully request that the 35 USC § 103 rejection of independent claims 1, 10 and 19 as well as dependent claims 2-9, 11-18 and 20-21 be withdrawn.

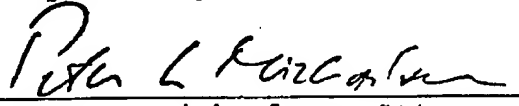
#### Conclusion

Thus, the Applicants submit that none of the claims, presently in the application, is obvious under the provisions of 35 USC § 103.

Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

Respectfully submitted,

May 11, 2004

  
Peter L. Michaelson, Attorney  
Customer No. 007265  
Reg. No. 30,090  
(732) 530-6671

Appl. No. 09/616,605  
Amdt. dated May 11, 2004  
Reply to Office Action of Feb. 12, 2004

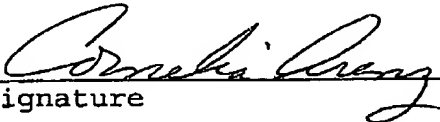
MICHAELSON & ASSOCIATES  
Counselors at Law  
Parkway 109 Office Center  
328 Newman Springs Road  
P.O. Box 8489  
Red Bank, New Jersey 07701

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

Cornelia Arenz

Type or print name of person signing certification

  
Signature

May 11, 2004  
Date

(UCC16AMEND/ca:58)